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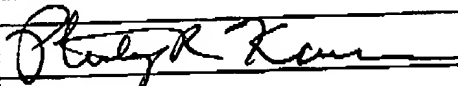
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/524,590	
	Filing Date	March 14, 2000	
	First Named Inventor	Philip R. Krause	
	Art Unit	2178	
	Examiner Name	Chau T. Nguyen	
Total Number of Pages in This Submission	35	Attorney Docket Number	

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In the United States Patent and Trademark Office

Appn. Number: 09/524,590
Appn. Filed: March 14, 2000
Applicant: Philip R. Krause
Customer No: 35197
Title: Method and Apparatus for Enhancing Electronic Reading by
Identifying Relationships Between Sections of Electronic
Text
Examiner/GAU: Chau T. Nguyen/2176
Date: September 11, 2005

Reply Brief

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The attached Reply Brief is submitted pursuant to 37 CFR 41.41. The corresponding notice of appeal was filed on March 3, 2005, the appeal brief was filed on May 3, 2005, and the USPTO's Examiner's Answer Brief was mailed on July 26, 2005.

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REPLY BRIEF

In this Reply Brief, after presenting a brief summary of the arguments to aid the Board's consideration of the issues, the Appellant will consider the specific arguments made in the Appeal Brief of May 3, 2005, and explain the deficiencies in the USPTO's Examiner's Answer Brief of July 26, 2005 with respect to these arguments and issues. The Appellant's arguments fall into two main categories.

1. Claims 36, 39, 42, 43, 52, 53, 54, 58, 60, 61, 66, 68, and 69 contain specific limitations not disclosed by the references cited by the USPTO.

While the USPTO has stated that an individual with ordinary skill in the art would have been able to reproduce the claimed invention, with reference to a limited set of references that clearly do not disclose the entire invention (for example, see Section A.1.a.2, and A.1.b), there has been no indication of precisely which steps in the Appellant's Invention the USPTO is imputing to the knowledge of such an individual, nor of what specific principles known to such an individual it believes would allow this individual to arrive at the Appellant's invention (see Sections A.1.a.3 and A.1.b). Moreover, the USPTO has not shown that all dependent claims are disclosed by the cited references (see relevant portions of Sections A.2 and B.1). The USPTO has not established a *prima facie* case that the Appellant's invention is obvious, and rejection under U.S.C. Section 103 is thus improper.

2. The USPTO has not provided valid motivation for combining references relevant to rejection of claims 36, 42, 68, and 69, and objective evidence further suggests that the cited references should not be combined. Moreover, the USPTO has not provided valid motivation for combining references relevant to

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rejection of claims 41, 44, 45, 46, 47, 50, 59, 60, 62, and 63, which further limit steps in an independent claim not disclosed by the reference asserted to disclose each dependent claim.

In particular, the motivations cited in the Examiner's Answer Brief are irrelevant to the actual claims, and no plausible argument is proffered regarding any basis for combining the cited references to arrive at the Appellant's specific claims, in contravention to requirements of a long series of cases, well summarized in In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (see Section A.1.d.I). While motivation may come from the references, the nature of the problem solved, or the knowledge of an individual with ordinary skill in the art, the USPTO provides justification for none of these possible motivations.

For example, the "motivations" cited in support of combining references are irrelevant to the Appellant's invention (see Section A.1.d.I), the cited prior art solves completely different problems from the Appellant's invention and is non-analogous (so the nature of the problem solved by the Appellant's invention would not provide motivation to combine, see Sections A.1.c and B.1.a), and no specific knowledge available to an individual with ordinary skill in the art is described, that would motivate such an individual to make the suggested combination (see Section A.1.d.I). Indeed, in resolving the level of ordinary skill in the art (see Section A.1.a.3), the USPTO makes no suggestion that such an artisan would have any specific knowledge or motivation related to the Appellant's invention, other than that in the cited references.

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The completeness of the cited references in solving their respective problems further argues strongly against their combination (see Section A.1.d.II and B.2.b). Moreover, other objective arguments (summarized in Section A.1.a.4) against combining the cited references are not convincingly addressed: one of the references teaches away from combination with other references and against the Appellant's invention (see Section A.1.d.III), and probability of success in combining the cited references has not been established (see Section A.1.d.IV and B.2.c). Moreover, proper motivation to combine references also is not provided in rejection of the dependent claims (see relevant portions of Sections A.2 and B.2.b).

Thus, even if the combination of the cited references disclosed all elements of the Appellant's invention, motivation to combine these references has not been demonstrated, rendering further improper the USPTO's rejection of the claims under U.S.C. Section 103.

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 - b. Specific limitations in independent claims 36, 68, and 69 are not described in the prior art relied on in the rejection (p. 9).
 - c. The references, taken as a whole, do not suggest the subject matter of claims 36, 68 and 69 (p. 16).
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2. Specific limitations in the dependent claims are not described in the prior art relied on in the rejection, and appropriate motivation for combination of references to arrive at dependent claims is not provided (p. 24).

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1. The references, taken as a whole, do not suggest the subject matter of claim 42 (p. 30).
2. Features disclosed in one reference may not properly be combined with features disclosed in another reference (p. 31).
 - a. No motivation to combine Sotomayor with Meske and Boguraev is described in the references or in the knowledge generally available to one of ordinary skill in the art (p. 31).
 - b. Sotomayor, Meske, and Boguraev are individually complete (p. 32).
 - c. There is no reasonable expectation of success in combining Sotomayor with Meske or Boguraev. Reasonable expectation of success is the standard with which obviousness is determined (p. 33).

A. Claims 36-41, 43-69 are rejected under 35 U.S.C. 103 over Sotomayor in view of Meske.

1. General arguments common to all claims

- a. The final rejection contains errors in reasoning, fails to properly apply the Graham (Graham v. John Deere Co.) factual inquiries, and does not establish a prima facie case of obviousness.

Rebuttal points related to USPTO's comments regarding the Graham factual inquiries are as follows:

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I. *Determining the scope and contents of the prior art.* The prior art cited by the USPTO, in addressing the Appellant's specific claims, includes Sotomayor (U.S. P.N. 5,708,825, summarized in Appeal Brief pp. 6-7), Meske (U.S. P.N. 5,530,852, summarized in Appeal Brief, p. 7) and Boguraev (U.S. P.N. 6,212,494, summarized in Appeal Brief, p. 8). Although stating that it is proper to take into account not only specific teachings of the reference, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (Examiner's Answer Brief, p. 17), the USPTO has not specifically identified any inferences beyond the quoted disclosures of these references that it believes one skilled in the art would identify from them, or any basis for applying conclusions beyond those directly supported by the references. Thus, in considering the USPTO's arguments, it is appropriate to restrict the analysis to the disclosures in the cited references (see also Section A.1.b, regarding the USPTO's assertion that common knowledge or common sense may fill in some of these gaps).

II. *Ascertaining the differences between the prior art and the claims at issue.* The USPTO attempted to meet this requirement by describing where in Sotomayor it believes invention steps (a) and (c) may be found, and with an admission that Sotomayor does not disclose steps (b), (d) or (e) (Examiner's Answer Brief, pp. 17-20). However, according to MPEP 1208(A)(10)(d), the USPTO should point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection. While this has not been explicitly done by the USPTO in any of the Office Actions or in the

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Examiner's Answer Brief, the Appellant now provides a mapping (of claim limitations to references asserted by the USPTO to disclose those limitations) for independent claim 36 (and by analogy independent claims 68 and 69) in the present Reply Brief, in Section A.1.b. Examination of this mapping shows that the cited references do not, in fact, disclose the limitations of the Appellant's invention; thus, there are substantial differences between the prior art and the claims at issue. Moreover, examination of the dependent claims (see Sections A.2 and B.1) shows that dependent claims 39, 42, 43, 52, 53, 54, 58, 60, 61, and 66 are also not disclosed by the cited references, a fact stated in the Appeal Brief and (for most of these dependent claims) not directly disputed in the Examiner's Answer Brief. Of course, an additional significant difference between the Appellant's invention and the cited references is the need to combine these references to arrive at some of the steps of Appellant's invention, a combination that is inappropriate for reasons shown in the Appeal and Reply Briefs (Section A.1.c, A.1.d, and B.2).

III. *Resolving the level of ordinary skill in the pertinent art.* The USPTO does not claim an unusual level of ordinary skill in the pertinent art, asserting only that such an individual would have the capability of understanding the scientific and engineering principles applicable to the pertinent art (Examiner's Answer Brief, p. 20). Thus, no specific knowledge or principles are imputed to an individual with ordinary skill in the pertinent art that would either allow such an individual to arrive at the Appellant's invention or motivate such an individual to combine references, especially for the purpose of solving a problem not

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suggested by the pertinent art. Thus, the gaps between the prior art and the claims at issue cannot be assumed to be filled in by an individual with ordinary skill in the pertinent art.

IV. *Considering objective evidence present in the application indicating obviousness or nonobviousness.* In the Appeal Brief, the Appellant provided objective evidence and arguments related to the non-obviousness of the invention, that have not been refuted by the USPTO. This includes the facts that the cited references are individually complete (Appeal Brief and Reply Brief Sections A.1.d.II and B.2.b), solve different problems from that of the Appellant's invention and are non-analogous art (Appeal Brief and Reply Brief Sections A.1.c and B.1.a), that one of the cited references teaches away from combination with the other references and from the Appellant's invention (Appeal Brief and Reply Brief Section A.1.d.III), and the absence of reasonable expectation of success in combining the cited references (Appeal Brief and Reply Brief point Sections A.1.d.IV and B.2.c). Thus, consideration of this objective evidence also supports the Appellant's conclusion that combination of the cited references is improper, and that the claimed invention is non-obvious under U.S.C. Section 103. In response, the USPTO (Examiner's Answer Brief, pp. 20-22) repeated its assertion that Sotomayor discloses steps (a) and (c), repeated its concession that Sotomayor does not disclose steps (b), (d) or (e), asserted that Meske contains information relevant to step (c), claimed that Sotomayor and Meske are analogous art, and suggested a new motivation to combine Sotomayor and

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Meske. However, none of the Appellant's other arguments summarized in Section A.1.a.4 were directly addressed in the Examiner's Answer Brief.

b. Specific limitations in independent claims 36, 68, and 69 are not described in the prior art relied on in the rejection.

The Appellant argued that limitations in the independent claims are not described in the prior art relied on in the rejection (Appeal Brief, pp. 10-17). The USPTO implied a belief that they are, referring to its response to Section A.1.a (Examiner's Answer Brief, p. 22).

The following table addresses the elements of claim 36, attempting to identify the sources within the cited references that the USPTO claims to disclose these elements, and describes the arguments relative to these "disclosures" (not refuted by the USPTO in the Examiner's Answer Brief) presented by the Appellant in the Appeal Brief.

CLAIM element	According to USPTO, disclosed by:	Appellant argument
36. A method for using a computer system, in response to a reader's request for display of electronic text, to automatically identify and provide additional reading material related to concepts referred to within said electronic text comprising, in sequence, the steps of:	Asserted to be disclosed by Sotomayor, but no location given	Sotomayor/Meske do not automatically identify and provide additional reading material referred to within electronic text requested for display by reader Sotomayor/Meske do not perform the claimed steps in sequence (Appeal brief, pp. 10-11, 14).
a) accessing, using the	Disclosed by Sotomayor	Sotomayor and Meske

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reader's computer, electronic text requested for display by the reader, said electronic text containing at least one text section;	(Examiner's Answer Brief, pp. 4, 18 citing Sotomayor: col 5, line 53-col. 7, line 10: a viewer viewing documents uses a web browser to access documents)	access text, but not in the context of or in sequence with other steps of the invention. (Appeal brief, p. 11)
b) using said at least one text section to automatically formulate, on the reader's computer, a search request related to a concept referred to in said at least one text section;	Not disclosed by Sotomayor (Examiner's Answer Brief, pp. 5, 20, 21 "Sotomayor does not explicitly disclose b). . . , d). . . and e). . .") No indication that this is disclosed by Meske	Despite careful examination, Appellant cannot find any step in Sotomayor or Meske that is even remotely analogous to step b. (Appeal brief, pp. 11-13).
c) responsive to said search request, automatically searching an index, wherein i) said index contains a plurality of terms by which it may be searched; ii) substantially all terms in said index are associated with at least one pointer to a text section; and	USPTO (Examiner's Answer Brief pp. 4-5 and 18-19) describes features of an index provided by Sotomayor, but does not show or claim that said index is searched. (Sotomayor col. 3, line 41-col. 4, line 8; col 6 lines 31-48, col. 8, lines 44-60, col 35, lines 48-57 describe said index) (Sotomayor, col. 3, line 41-col. 4, line 8, col 6 lines 31-48, and col. 8, lines 44-62 and Abstract)	Sotomayor does not search an index. (Appeal brief p. 14), thus, Sotomayor does not disclose this limitation. Steps referenced by USPTO in Sotomayor or Meske are not responsive to a search request meeting limitation of step b, and thus do not meet the limitation of step c, which begins, "responsive to said search request." (Appeal brief, p. 14)

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iii) at least one term in said Index is associated with a plurality of pointers, at least two of said plurality of pointers pointing to different text sections;	<p>Sotomayor, col. 3, line 41-col. 4, line 21 and col. 8, lines 44-62 describing said index</p> <p>USPTO does not explicitly map sub-limitations i - iii to Meske, but now asserts (Examiner's Answer Brief, p. 21): "Meske, Jr. discloses a method for retrieving information by displaying to a user a display generated from a first markup language containing a list of profiles and at least one corresponding topic for each of the list of profiles and allowed user to enter search term (search an index in step c) (Fig. 10), and the search is performed using the search term in a database which is organized by the list of the profiles and the at lest [sic] one corresponding topic for each of the list of profiles (col. 2, line 56 – col. 3, line 8)</p>	Although Meske permits user entry of a search term, this search is not neither automatic nor performed in sequence with other steps of the invention (Appeal brief, pp. 14-15). This argument is not addressed in the Examiner's Answer Brief.
d) responsive to step (c), automatically identifying	Not disclosed by Sotomayor (Examiner's Answer Brief, pp. 5, 20, & 21 "Sotomayor does	

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additional reading material related to said concept; and	<p>not explicitly disclose b). . . , d). . . and e). . .")</p> <p>USPTO does not either specifically map this step to Meske. Appellant believes that the following statement in Examiner's Answer Brief, p. 21 is intended to address step (d): "Meske Jr. also discloses the search result may also create certain HTML files responsive to user search requests (in response to step c above) and additional HTML file created responsive thereto, wherein anchors are created in the various files in order to allow hypertext cross-referencing of the various related file and/or documents (col. 5, lines 58-col. 7, line 2, Figs. 9, 10, 11A-11C, and 12A-12B).</p>	<p>In Meske, reading material related to a manually input search term is identified, but this is not "related to said concept" of the invention, but instead simply represents the HTML documents present in a database, responsive to a manually input search requesting such documents using pre-specified index terminology. Since Meske does not disclose step (c), it is impossible for Meske to disclose step (d), which is responsive to step (c). (Appeal brief, pp. 15-16).</p>
e) automatically displaying on said reader's computer display, an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text	<p>Not disclosed by Sotomayor (Examiner's Answer Brief, pp. 5, 20, 21 "Sotomayor does not explicitly disclose b). . . , d). . . and e). . .")</p> <p>No indication that this step is disclosed by Meske</p>	<p>Despite careful examination of Sotomayor and Meske, Appellant is unable to identify any step analogous to step e) in either reference. (Appeal brief, p. 16)</p>

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referred to in step (a).		
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This table demonstrates substantial differences between the Appellant's invention and the references cited by the USPTO. In addition, it is clear that specific arguments made in the Appeal Brief regarding these differences remain unrefuted by the USPTO in its Examiner's Answer Brief. Thus, the USPTO has not demonstrated that the Appellant's invention is disclosed by these references.

In the Examiner's Answer Brief, the USPTO states that it is proper to take into account not only specific teachings of the reference, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (Examiner's Answer Brief, p. 17). However, the USPTO has not specifically identified any inferences beyond the quoted disclosures of these references that it believes one skilled in the art would identify from them, or any basis for applying conclusions beyond those directly supported by the references. Without a specific argument regarding how one skilled in the art would know, from reading Sotomayor and Meske, to perform in sequence each step of the Appellant's invention, especially those that are not disclosed in either reference, the USPTO's argument cannot hold. Otherwise, the USPTO would be permitted to reject all patent applications based on similar conclusory assertions, a consequence clearly not supported by legislation, regulation, MPEP, or the relevant case law.

The USPTO, in response to the argument that Sotomayor teaches away from the Appellant's invention (see Section A.1.d.III) further presents the new

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argument that *In re Bozek* permits a conclusion of obviousness based on common knowledge and common sense, without specific suggestion in the references (Examiner's Answer Brief, pp. 24-26):

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 738, 1385 USPQ 545 (CCPA 1969).

However, in *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), the Court explained the context in which *In re Bozek* should be considered:

The case on which the Board relies for its departure from precedent, *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969), indeed mentions "common knowledge and common sense," the CCPA stating that the phrase was used by the Solicitor to support the Board's conclusion of obviousness based on evidence in the prior art. *Bozek* did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. *Bozek* did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. Nor does *Bozek*, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence. This court has remarked, in *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F. 3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999), that *Bozek*'s reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge.

This same line of reasoning was subsequently reaffirmed by the Court, in *In re Thrift*, 298 F.3d 1357, 1363-64, 63 USPQ2d 2002, 2007-08 (Fed. Cir. 2002). Thus, *In re Bozek* provides no support for an assertion that limitations not taught by the references would have been obvious to an artisan of ordinary skill, absent

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specific evidence of such knowledge at the time the invention was made (see also Section A.1.b).

Moreover, MPEP 2143.03 directs that "all claim limitations must be taught or suggested." Considering the substantial differences between the Appellant's invention and the cited references, it is not appropriate to rely on the knowledge of an individual with ordinary skill in the art to fill in these differences. Indeed, according to MPEP 2142, citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985), "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

MPEP 2144.03 further states,

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.") . . . Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.2d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). . . . If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.

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Absent presentation of a sound line of reasoning as to *why* the artisan would have found all steps of the claimed invention to have been obvious in light of the teachings of the references, the USPTO has not satisfied its burden of establishing a *prima facie* case of obviousness.

c. The references, taken as a whole, do not suggest the subject matter of claims 36, 68 and 69.

It is clear that both the cited references and the Appellant's invention must be considered as a whole:

The claimed invention must be considered as a whole... The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (MPEP 2141 and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986)).

This is important for several reasons. First, the Appellant's invention clearly solves a different problem than the cited references (see Appeal Brief, pp 17-18). Thus, motivation to combine the USPTO's references cannot be found in the nature of the problem to be solved (nor does the USPTO claim that the nature of the problem to be solved would have motivated an artisan of ordinary skill to combine these references). Second, it is clear that neither reference suggests the *desirability* of making the USPTO's combination (Appeal Brief, p. 18). Third, the USPTO's rejection involves a particularly tortuous combination of Sotomayor and Meske, wherein Sotomayor is asserted to disclose only steps (a) and (c), and Meske is implied to disclose steps (c) and (d), and the USPTO provides no clear source from which steps (b) or (e) might be derived.

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However, (see Section A.1.b and Appeal Brief, p. 22), the steps from Sotomayor and Meske that are asserted to correspond to the Appellant's invention are not performed in sequence in Sotomayor and Meske, as is required by the Appellant's claims. Thus, the need to consider each invention as a whole further militates against combination of Sotomayor with Meske to arrive at the Appellant's invention.

In the Examiner's Answer Brief (p. 22), the USPTO responds by asserting that it has demonstrated motivation to combine the references. This response does not refute any of the arguments made in the Appeal Brief.

d. Features disclosed in one reference may not properly be combined with features disclosed in another reference to arrive at claims 36, 68, or 69.

I. No motivation to combine Sotomayor with Meske is described in the references or in the knowledge generally available to one of ordinary skill in the art.

Detailed arguments regarding the inappropriateness of combining Sotomayor and Meske to arrive at the Appellant's invention are described in the Appeal brief, pp. 18-25.

The following new motivation is cited by the USPTO in the Examiner's Answer Brief, for combination of Sotomayor with Meske (Examiner's Answer Brief, p. 23):

The suggestion/motivation for doing so would have been to provide information retrieval, which "includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the

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portions of information to allow hypertext viewing and accessing.”
[Quotation marks added by the Appellant to indicate text taken from
Meske's description of the field of the invention, col. 1, lines 16-22].

It is quite clear that this statement describes, in general terms, the invention described by Meske (and is, in fact, a direct quotation from Meske). Meske receives information, pre-organized by profile and topic, and creates a database (organized by these pre-specified profiles and topics) from this information, allowing retrieval of the information in hypertext form in response to specific search requests manually input by a user. However, a general desire to provide improved means of information retrieval cannot be construed as a motivation to combine existing references to effect this outcome in all possible ways—there must be something specific about the actual references, rather than just their field, to suggest the combination, and it is also necessary to show motivation for a specific combination leading to the Appellant's invention.

The motivation cited by the USPTO is so general that based on its argument, motivation could be found to combine Meske with any other reference, regardless of field. Because Meske already provides information retrieval, any combination of Meske with any other reference would presumably still provide that function, which is asserted by the USPTO to be the primary motivation for combination of Meske with specific aspects of Sotomayor. Statements of purpose exist in almost all references, and if it were possible to use these statements as motivation for combinations with all other references, the requirement to show motivation to combine references would be completely meaningless.

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Because Meske itself already provides a means to provide information retrieval of a plurality of information organized by profile and topic in a first markup language, there is no indication that Meske considered the use of its database construction techniques in identifying and displaying, in real time, an indicator of additional reading material conceptually related to text requested for display by a user (as the Appellant's invention does). Although it is conceivable that the summary page of Sotomayor could be construed as "a plurality of information, organized by topic in a first markup language", incorporation of that summary page in Meske would not result in the Appellant's invention, nor would it have any utility in solving the problem solved by the Appellant's invention, and thus, the coincidence that the two inventions involve similar data structures does not by itself suggest that the inventions be combined in ways not involving those data structures. In addition, even if Meske had suggested using techniques from Sotomayor in solving the problem of the Appellant's invention, this would still not have led to the Appellant's invention, since the Appellant's invention does not construct any databases analogous to those constructed by Meske in response to receipt of a plurality of information organized by profile and topic in a first markup language.

Moreover, because Sotomayor does not perform (nor does it contemplate performing) any searches as a result of a request for text display, it is unclear what would motivate an artisan of ordinary skill to use Sotomayor's invention to provide any output to the invention of Meske, for the purpose of allowing searches.

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Neither the specification of Meske nor the Examiner's Answer Brief provides any explicit indication of how Meske might be combined with Sotomayor or other inventions, in order to arrive at the Appellant's invention. The specification for Meske provides motivation for Meske alone, reciting the specific problem that Meske solves, which is different from that of the Appellant's invention.

To reiterate, in In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), the standard for showing motivation to combine references is made clear.

"The factual inquiry whether to combine references must be thorough and searching." Id. [Referring to McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).] It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'")(quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)(there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.")(emphasis in original)(quoting ACS Hosp. Sys., Inc., v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet,

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149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir., 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."). . . . The Examiner's conclusory statements . . . do not adequately address the issue of motivation to combine.

It is clear that a general motivation to combine one or more references is not sufficient. It is necessary to show motivation to combine the relevant teachings of the references *in the manner claimed*. As noted in the Appeal Brief (pp. 20-21), *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) further states that obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do **what the patent applicant has done**" (emphasis added).

The Appellant submits that the motivations to combine references (whether Sotomayor with Meske, or Sotomayor with Meske and Boguraev [see Section B.2.b]) provided by the USPTO simply do not meet this test. The provided, general conclusory statements do not provide any objective evidence of any reason why anyone, without the benefit of hindsight, would have selected the individual components from these references that the USPTO chose, or to combine them in a fashion inconsistent with their original purpose.

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II. Sotomayor and Meske are individually complete.

The Appeal Brief (pp. 22-23) argues that the individual completeness of Sotomayor and Meske militates against their combination to solve an unrelated problem, such as that solved by the Appellant's invention. The USPTO responded by stating that these references are in a similar field, and thus are considered analogous art, and thus that it is appropriate to combine them (Examiner's Answer Brief, p. 24).

However, characterization of references as analogous art is a minimum standard that is necessary in order to combine them, but does not by itself provide a sufficient basis to make the combination (see MPEP 2141.01(a)).

Moreover, the USPTO (Examiner's Answer Brief, p. 21) asserts that "Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor, that is retrieving information from index files." The Appellant respectfully points out that Sotomayor does not retrieve information from index files (Sotomayor creates a summary page, which in some ways resembles an index, but Sotomayor performs no searches/retrievals, as pointed out in the Appeal Brief, p. 14, and not disputed in the USPTO's Examiner's Answer Brief), and thus, based on the USPTO's analysis, perhaps should not even be considered as art analogous either to Meske or to the Appellant's invention.

The arguments presented in Section A.1.c are also relevant to this issue. Moreover, the USPTO has not provided a refutation of the argument in the Appeal Brief with respect to this point.

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Thus, the USPTO has not met the minimum standard necessary in order either to use Sotomayor in a determination of obviousness, or to combine Sotomayor with Meske.

III. Sotomayor teaches away from the Appellant's invention and from combination with Meske.

In responding to this argument (presented in the Appeal Brief, pp. 23-24), the USPTO (Examiner's Answer Brief pp. 24-26) recites the basis for its Section 103(a) rejection of claim 36 under Sotomayor and Meske, and provides the same rationale for the combination as was described in Section A.1.d.I above. However, the USPTO does not address the fact that Sotomayor is involved in decreasing the amount of reading material that a user must examine, while the Appellant's invention and Meske are engaged in increasing the amount of material that must be considered (Appeal Brief, pp. 23-24). Thus, Sotomayor teaches away both from the Appellant's invention and from combination with Meske, an argument that is not addressed in the Examiner's Answer Brief. Because Sotomayor (which must be considered as a whole) teaches away from the present invention and from combination with Meske, it seems that combination with Meske would render Sotomayor unfit for its originally intended purpose, a basis for disallowing the combination (see MPEP 2145.X.D, citing In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

In the Examiner's Answer Brief's response to this point, the USPTO further asserts that *In re Keller* and *In re Bozek* permit a finding of obviousness

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based on common knowledge and common sense. That argument is addressed in Section A.1.b of this brief.

IV. There is no reasonable expectation of success in combining Sotomayor with Meske. Reasonable expectation of success is the standard with which obviousness is determined. (Appeal brief, p. 25).

The USPTO does not provide its rationale for believing that combination of Sotomayor with Meske would meet with a reasonable expectation of success. The USPTO has never disclosed how it would combine these references to arrive at the Appellant's invention (see Section A.1.b and A.1.d.i). The Appellant thus continues to believe that any combination of these references has no reasonable expectation of success in arriving at the Appellant's invention. The USPTO has not provided an argument in this regard for the Appellant to rebut, and also provides no response to this argument presented in the Appeal Brief (p. 25). Nonetheless, it is clear that without demonstrating reasonable expectation of success, combination of the references is improper (MPEP 2141, and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986)).

2. Specific limitations in the dependent claims are not described in the prior art relied on in the rejection, and appropriate motivation for combination of references to arrive at dependent claims is not provided.

a. CLAIM 39

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In the Appeal brief (pp. 26-27), the Appellant examined the cited sections of Meske, and was unable to identify any material relevant to claim 39. In the Examiner's Answer Brief (p. 26), the same sections of Meske are cited, but no indication is given of how the cited material is considered to disclose claim 39. Thus, the Appellant continues to believe that the limitations in claim 39 are not disclosed by the cited references.

b. CLAIMS 41, 44, 45, 46, 47 and 50

In the Appeal brief (p. 27), the Appellant pointed out that these claims modify limitation (b) of claim 36 (hereinafter referred to as claim 36(b)), which according to the USPTO is not disclosed by Sotomayor (Examiner's Answer Brief, pp. 5, 20, & 21). While the USPTO also has not explained where claim 36(b) is disclosed in Meske (see Section A.1.b), these dependent claims are rejected based on disclosures in Sotomayor, which the USPTO concedes not to have any relevance to claim 36(b). Thus, while Sotomayor does perform various analyses of a text, none of these analyses are done in the context of the formulation of a search request, and no search request is described by Sotomayor. Although Meske allows searches to be done, these searches are restricted to those explicitly input by a user. Thus, the Appellant believes that, for the rejections of the limitations in these dependent claims to stand, it would be necessary for the USPTO to show some motivation for using the analyses of Sotomayor in the formulation of a search request—a motivation that clearly does not appear in either reference. In response, the Examiner's Answer Brief (p. 27)

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asserts that there is no need to provide motivation. The Appellant respectfully disagrees.

c. CLAIM 43

In the Appeal Brief (p. 28), the Appellant argues that the limitations of this claim are not disclosed either by Sotomayor or Meske. Claim 43 describes specific data (shared citation of references) to be used in automatic formulation of a search request. In response (Examiner's Answer Brief, pp. 27-28), the USPTO indicates that Meske allows searches based on profiles, which describe the source documents of the material indexed by Meske. However, this function of Meske is not germane to examining passages of text for citation of the same references in order to determine whether or not they are related, nor is it germane to formulation of a search request. The cited material simply repeats the USPTO's basis for rejecting claim 36, and does not describe the use of the cited references in formulating a search request, as would be necessary for the limitations added by claim 43 to be disclosed. Thus, none of the material cited by the USPTO is relevant to the specific limitation of claim 43, so claim 43 is not disclosed by the references cited by the USPTO.

d. CLAIMS 52-54

In the Appeal Brief (p. 29), the Appellant argues that the material in Sotomayor and Meske cited by the USPTO does not disclose the limitations of these claims. The Examiner's Answer Brief provides no further indication of

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where in Sotomayor or Meske the limitations found in claims 52-54 may be found (Examiner's Answer Brief, pp. 28-29). The USPTO also asserts that the above-cited motivation for combining Sotomayor with Meske to arrive at claim 36 would also apply to claim 53. This argument is in error for the same reason that it is with respect to claim 36 (see Section A.1.d).

e. CLAIM 58

In the Appeal Brief (p. 30), the Appellant pointed out that the limitation of claim 58 is not disclosed by the cited reference. In the Examiner's Answer Brief (p. 29), no indication is provided of where in the cited references this limitation may be found.

f. CLAIM 59

In the Appeal Brief (p. 31), the Appellant pointed out that claim 59 further limits limitation (e) of claim 36 (hereinafter referred to as claim 36(e)), which the USPTO expressly acknowledges not to be disclosed by Sotomayor (Examiner's Answer Brief, pp. 5, 20, & 21), but that claim 59 is rejected based on a reference to Sotomayor. The Appellant questioned the appropriateness of making this combination, when the USPTO concedes that the features described in Sotomayor are irrelevant to the output of the Appellant's invention, as described in claim 36(e). Thus, the Appellant continues to believe that incorporation of features from Sotomayor into a rejection of claims dependent on 36(e) is inappropriate, without examination of the motivating factors for doing so. In the

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Examiner's Answer Brief (p. 29), the USPTO asserts that there is no reason to provide motivation. The Appellant respectfully disagrees.

g. CLAIM 60

In the Appeal Brief (pp. 31-32), the Appellant pointed out that the limitation of claim 60 is not disclosed by the cited reference. In the Examiner's Answer Brief (p. 29), no indication is provided of where in the cited prior art this limitation may be found.

In the Appeal Brief (p. 31), the Appellant also pointed out that claim 60 limits claim 36(e), which the USPTO expressly acknowledges not to be disclosed by Sotomayor (Examiner's Answer Brief, pp. 5, 20, & 21), but that claim 60 is rejected based on a reference to Sotomayor. The Appellant questioned the appropriateness of making this combination, when the USPTO concedes that the features described in Sotomayor are irrelevant to the output of the Appellant's invention, as described in claim 36(e). Thus, the Appellant continues to believe that incorporation of features from Sotomayor into a rejection of claims dependent on 36(e) is inappropriate, without examination of the motivating factors for doing so. In the Examiner's Answer Brief (p. 29), the USPTO asserts that there is no reason to provide motivation. The Appellant respectfully disagrees.

h. CLAIM 61

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In the Appeal Brief (p. 32-34), the Appellant pointed out that the limitation of claim 61 is not disclosed by the cited reference. In the Examiner's Answer Brief, no further statement is made about claim 61, and thus, no indication is provided of where in the cited references this limitation may be found.

i. CLAIMS 62 and 63

In the Appeal Brief (p. 34), the Appellant pointed out that claims 62 and 63 further limit limitation (d) of claim 36 (hereinafter referred to as claim 36(d)), which the USPTO expressly acknowledges not to be disclosed by Sotomayor (Examiner's Answer Brief, pp. 5, 20, & 21), but that claims 62 and 63 are rejected based on a reference to Sotomayor. The Appellant questioned the appropriateness of making this combination, when the USPTO concedes that the features described in Sotomayor are irrelevant to the limitation described in claim 36(d). Thus, the Appellant continues to believe that incorporation of features from Sotomayor into a rejection of claims dependent on claim 36(d) is inappropriate, without examination of the motivating factors for doing so. In the Examiner's Answer Brief (p. 29), the USPTO asserts that there is no reason to provide motivation. The Appellant respectfully disagrees.

j. CLAIM 66

In the Appeal Brief (pp. 34-36), the Appellant pointed out that the limitation of claim 66 is not disclosed by the cited reference. In the Examiner's Answer Brief (pp. 29-30), no indication is provided of where in the cited references this

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limitation may be found, or what additional information resident on the reader's computer the USPTO believes these references show to be influencing said search request. Thus, the Appellant continues to believe that the limitation of dependent claim 66 is not disclosed by the cited references.

B. Claim 42 is rejected under 35 U.S.C. 103 over Sotomayor in view of Meske and Boguraev.

Please see all of Section A, which shows why Sotomayor and Meske do not disclose the steps of the invention, and that combination of Sotomayor and Meske is inappropriate, as the arguments presented there also apply to rejection of Claim 42 over Sotomayor in view of Meske and Boguraev.

1. The references, taken as a whole, do not suggest the subject matter of claim 42.

Please see Section A.1.c, as the arguments presented there also apply to rejection of Claim 42 over Sotomayor in view of Meske and Boguraev.

The Appeal Brief presented the argument that Boguraev does not suggest the additional limitation of Claim 42, even if Sotomayor and Meske were considered to suggest the subject matter of independent claim 36, on which claim 42 depends (Appeal Brief, p. 37). While Boguraev provides a means of producing an improved index, identifying some important concepts based on proximity of terms or their relative position in a text, this activity is restricted to using this information in the context of producing the index. There is no indication that Boguraev suggested the use of these methods in the formulation

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of search requests, a requirement of claim 42, or in the context of a reading environment. The Examiner's Answer Brief (pp. 30-31) provides no refutation of these arguments. Thus, by itself, Boguraev does not suggest the limitation of Claim 42.

2. Features disclosed in one reference may not properly be combined with features disclosed in another reference.

a. No motivation to combine Sotomayor with Meske and Boguraev is described in the references or in the knowledge generally available to one of ordinary skill in the art.

Please see Section A.1.d, as the arguments regarding failure to demonstrate motivation to combine Sotomayor with Meske also apply to combination of Sotomayor with Meske and Boguraev.

The motivation for combination of Sotomayor, Meske and Boguraev, described in the Examiner's Answer Brief (p. 31) is as follows:

Since Bugaraev [sic] teaches a method for creating a glossary, index, help database or the like, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the index method of Bugaraev into the search system of Sotomayor-Meske to include gathering key terms on the basis of proximity in terms of relative position in the text. By doing so, it would create an online help database useful in providing online assistance to users in performing a task.

This is the identical motivation presented in the final Office Action, and refuted in the Appeal Brief (pp. 38-41). The Examiner's Answer Brief (p. 31)

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provides no counter-refutation to the Appellant's arguments in this regard, as presented in the Appeal Brief.

While Boguraev does provide means of producing an improved index, identifying some important concepts based on proximity of terms or their relative position in a text, this activity is restricted to using this information in the context of producing the index. There is no indication in Boguraev that these methods should be used in the automated formulation of search requests, a requirement of claim 42. Moreover, there is no indication that, even if such automatic formulation of search requests by this method were performed, it would provide any benefits in providing online assistance to users in performing a task. Thus, there is nothing in Boguraev to suggest that the described techniques used to produce an improved index be used in the context of Sotomayor or Meske, much less the Appellant's invention, or that doing so would yield an improved result. Thus, the cited "motivation" from Boguraev cannot be construed to provide motivation even for a general combination with Sotomayor or Meske, much less the very specific combination apparently contemplated by the USPTO in this rejection. The cited "motivation" of creating an online help database useful in providing online assistance to users in performing a task is simply a restatement of the problem that Boguraev solves (and is a direct quote from the abstract of Boguraev), and provides no motivation for using portions of Boguraev in unsuggested or novel ways.

b. Sotomayor, Meske, and Boguraev are individually complete.

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Please see Section A.1.c, as the arguments regarding the individual completeness of references also apply to rejection of claim 42. The Appeal Brief (p. 41) also made these arguments more specifically in relation to the individual completeness of all three references. The USPTO argues that Sotomayor, Meske, and Boguraev are analogous art from a similar field (Examiner's Answer Brief, p. 32), and thus it is appropriate to combine them. However, their individual completeness reduces the likelihood that an individual with ordinary skill in the art would combine them to solve a novel problem, not suggested by either reference.

c. There is no reasonable expectation of success in combining Sotomayor with Meske or Boguraev. Reasonable expectation of success is the standard with which obviousness is determined.

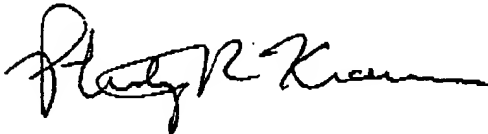
Please see Section A.1.d.IV, because the arguments presented there are also relevant to rejection of claim 42. This argument, presented in the context of combining all three references on pp. 42-44 of the Appeal Brief, was not addressed in the Examiner's Answer Brief. In order to claim reasonable expectation of success, at a minimum, USPTO would have needed to explain why it believes combination of Sotomayor, Meske and Boguraev to yield the Appellant's invention would yield an improved online help database, a problem already solved by Boguraev and which is completely irrelevant to the Appellant's invention.

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Conclusion

Over the course of this application's lengthy prosecution history, the arguments and evidence proffered by the USPTO have never supported an obviousness rejection under U.S.C. Section 103, for the reasons set forth in the Appellant's five responses to Office Actions and in the Appeal Brief (and as also summarized in the current Reply Brief, presently submitted in response to the Examiner's Answer Brief). The Appellant thus respectfully requests reversal of all of the USPTO's rejections of the claims of the Appellant's application.

Very Respectfully,



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